REMARKS

This Application has been carefully reviewed in light of the Office Action mailed March 29, 2005. At the time of the Office Action, Claims 1-21 were pending in the case. Applicant respectfully requests reconsideration of the claims and favorable action in this case.

Election/Restriction Requirement

The Applicant and the Examiner previously resolved (via the telephone) to prosecute Claims 1-9 initially. Applicant affirms this decision and hereby elects to prosecute Group I (Claims 1-9) in this Application. Applicant withdraws Claims 10-21 (Examiner's Group II) without prejudice or disclaimer for prosecution in a divisional application. This election was made in an effort to expedite prosecution of the pending subject matter and, further, does not reflect any agreement with (or acquiescence to) the propriety of the Examiner's conclusions in this regard.

Section 102 Rejection

The Examiner rejects Claims 1, 3-4, 6-7, and 9 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,795,444 issued to Vo et al. (hereinafter "*Vo*"). This rejection is respectfully traversed for the following reasons.

Independent Claim 1 recites:

> A method of call handling for a wireless access network, comprising:
>
> receiving at a call agent of a wireless access network a call origination for a mobile device;
>
> determining whether the mobile device is registered on the wireless access network;
>
> if the mobile device is not registered, determining at a mobility control function (MCF) whether the mobile device is active; and
>
> if the mobile device is active, connecting the call to the mobile device with a call agent based on a temporary line directory number (TLDN) assigned by the MCF and passed to the call agent in an extended session initiation protocol (SIP) message.

Applicant respectfully reminds the Examiner that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described,

in a single prior art reference.[1] In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim."[2] In regard to inherency of a reference, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic."[3] Thus, in relying upon the theory of inherency, an Examiner must provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.[4]

Using the preceding well-settled jurisprudence, it is clear that *Vo* fails to anticipate Independent Claim 1. For example, *Vo* fails to teach, suggest, or disclose a determination of whether the mobile device is registered on the wireless access network, as recited in Independent Claim 1. At the passage identified by the Examiner for this limitation, *Vo* offers a "...new subscriber category, called "Roaming Routing Over IP Network" (RROIP) 1650...,when this category is turned on, the call leg from the GMSC 1602 to the VMSC 1604 is routed over the IP network 108." (See *Vo* at Column 27: lines 10-15.)

I believe that the Examiner has made an honest mistake here in interpreting this passage. The "new subscriber category" does not correlate to a "new subscriber" group, which could (in theory) imply some type of registration. Instead, the "new subscriber category" being discussed by *Vo* is actually a *new category*, which (ostensibly) offers a new feature for a given subscriber. The category is new; the subscriber is not new. To avoid confusion, the drafting patent attorney could have used "new category" for a feature (namely Roaming Routing Over IP Network) offered to subscribers in the network, instead of the aforementioned "new subscriber category." The new category allows for a different type of routing for a set of packets. Specifically, the new category pertains to roaming over an IP network, which is reflected by its corresponding acronym and by the surrounding text that clearly indicates the same.

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[1] *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131.
[2] *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); MPEP §2131 (*emphasis added*).
[3] MPEP §2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (*emphasis in original*).
[4] MPEP §2112 (citing *Ex Parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. at App. and Inter. 1990) (*emphasis in original*).

Hence, there is no determination in *Vo* as to whether the user is registered. Applicant presumes that the configuration of *Vo* just assumes that the end user is registered in some fashion when the architecture begins performing its functions. For at least this reason, *Vo* cannot inhibit the patentability of the pending claims.

Also, once this determination is made, then a second determination is made as to whether the mobile device is active. This too is outlined the Independent Claim 1 and this too is missing from *Vo*. Only if the mobile terminal is active does a call get connected with a call agent. *Vo* also fails to disclose this connection limitation, which is predicated on the two previous determinations. At the passage cited by the Examiner for this teaching (Column 27: lines 43-46), *Vo* explains that calls are simply routed in a conventional manner over the PSTN. This is obviously disparate from the operations of the pending subject matter. Moreover, in contrast to the teachings of *Vo*, the call agent identified by Independent Claim 1 is connected with the mobile device based on a TLDN, which was assigned by the MCF and passed to the call agent in a SIP message. A generic reference to a TLDN element in connecting a call is not akin to providing a TLDN in the context of a two-step determination process, which includes a TLDN being assigned by an MCF and exchanged over SIP. Additionally, although *Vo* discusses the potential usage of SIP for signaling purposes, there is nothing in *Vo* that teaches or discloses such a SIP exchange between the identified components.

Thus, missing from *Vo* is any subject matter that would be relevant to an operation or a functionality that involves various tasks being completed by the MCF and the call agent, as highlighted supra. Applicant has evaluated *Vo* thoroughly and finds nothing that would anticipate the pending subject matter. At the passage cited by the Examiner for teachings that could be relevant to these operations, *Vo* discloses: "Referring now to FIGS. 13A-13C, depicted therein is a flow chart of an exemplary embodiment of the method of routing roaming calls over the IP network portion in accordance with the teachings herein. When an incoming call destined for the MS is received in the GMSC 1602, as provided in step 1708, the GMSC 1602 sends a LOCREQ_Invoke to the HLR 298 (step 1710). Responsive to the LOCREQ_Invoke, the HLR 298 issues a ROUTREQ_Invoke message to the VMSC 1604 (step 1714). Upon receiving the ROUTREQ_Invoke message in the VMSC 1604 (step 1716), a determination is made if Intersystem Paging is involved (decision block 1718). If

so, the VMSC 1604 sends an ISPAGE_Invoke message to the BSMSC 1699 (step 1720). Thereafter, responsive thereto, the BSMSC 1699 returns the ISPAGE_Return_Result to the VMSC 1604 with a TLDN and the IP address of its gateway, that is, GW-3 1698 (step 1722). Subsequently, in step 1724, the VMSC returns with ROUTREQ_Return_Result, including the IP address of either GW-2 or GW-3 (only if the Intersystem Paging is involved), the TLDN, and an instruction for the GMSC 1602 to route the call over the IP network 108, as appropriate. It can be seen that the control from the decision block 1718 flows directly to the step 1724 if the Intersystem Paging is not involved.

Upon receiving the TLDN and appropriate gateway IP address (step 1726), the HLR 298 determines if the RROIP flag is turned on (decision block 1728). If not, the TLDN may used in a conventional manner to route the call over the PSTN 102 (step 1730). Thereafter, the process control flow stops (step 1712). On the other hand, if the RROIP flag is turned on, another determination is made (decision block 1732) to ensure that the appropriate media GW's IP address is present and available. As an alternative network embodiment, when the VMSCs and BSMSCs are not aware of, or include, the GW's IP address, or if the GW's IP address is not present or available for some reason, a database 1691 containing the mapping from the TLDN to GW's IP address may be used by the HLR. Accordingly, the HLR 298 may optionally consult the database 1691 which contains the mapping from the TLDN to the appropriate GW's IP address (step 1734). Moreover, if the Intersystem Paging is involved, the TLDN is mapped to the IP address corresponding to GW-3. Otherwise, the TLDN is mapped to the IP address of GW-2 (associated with the VMSC 1604)." (See *Vo*: Column 27, lines 17-60.)

Clearly, this disclosure could not possibly anticipate a two-step determining process that dictates if the mobile device is active, connecting the call to the mobile device with a call agent based on a temporary line directory number (TLDN) assigned by the MCF and passed to the call agent in an extended session initiation protocol (SIP) message, as recited in Independent Claim 1. As highlighted by the passage above, the *Vo* architecture is not engaged in this endeavor, nor does it offer teachings that are even relevant to such operations. Accordingly, Independent Claim 1 is patentable over *Vo* for at least these reasons. Additionally, Independent Claims 4 and 7 recite a similar (but not an identical) limitation and are, therefore, also allowable for analogous reasons. In addition, their respective dependent

claims are also patentable over *Vo* using similar reasoning. Notice to this effect is respectfully requested.

Section 103 Rejection

The Examiner rejects Claims 2, 5, and 8 under 35 U.S.C. §103(a) as being unpatentable over *Vo* in view of U.S. Publication No. 2002/0080751 issued to Hartmaier (hereinafter "*Hartmaier*"). These rejections are respectfully traversed for the following reasons.

Applicant respectfully reminds the Examiner that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.[5]

It is respectfully submitted that the rejected claims are patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation of the Independent Claims. This issue has been evaluated extensively in the §102 analysis above.

Accordingly, all of the pending claims have been shown to be allowable as they are patentable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

[5] *See* M.P.E.P. §2142-43.

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fee is due. However, if this is not the case, the Commissioner is hereby authorized to charge any amount required or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas Frame at 214.953.6675.

Respectfully submitted,
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